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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,673	06/27/2003	Chul Chung	17209-340	8308
54205 7590 08/05/2009 CHADBOURNE & PARKE LLP 30 ROCKEFELLER PLAZA NEW YORK, NY 10112				
EXAMINER				
GREENE, DANIEL LAWSON				
ART UNIT		PAPER NUMBER		
3694				
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08/05/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/608,673

Applicant(s)

CHUNG, CHUL

Examiner

DANIEL L. GREENE JR.

Art Unit

3694

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 4-7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 8-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. The communication received 5/7/2009 has been considered and entered. Claims 1-16 are pending, with claims 1 and 8-11 being amended in said communication. Claims 4-7 were previously withdrawn. An action on the merits of claims 1-3 and 8-16 follows.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/7/2009 has been entered.

Response to Amendments and Arguments

3. Applicant's 5/7/2009 amendments to the claims and arguments in support thereof (see pages 10 and 11) have overcome the 35 USC 101 rejection set forth in section 3 of the previous Office action mailed 2/4/2009. Accordingly said rejection is withdrawn.
4. Applicant's 5/7/2009 amendments to the claims and arguments in support thereof (see page 9) have overcome the 35 USC 112 rejection set forth in section 6 of the previous Office action mailed 2/4/2009. Accordingly said rejection is withdrawn.
5. Applicant's arguments filed 5/7/2009, with regard to the 35 USC 102 and 103 rejections set forth in sections 7 and 9 of the previous Office action mailed 2/4/2009 have been fully considered but they are not persuasive.

Applicant argues on page 11:

“Some of the claim elements of independent claim 1 not found in May include:
...receive data identifying a reference entity participating in said derivative transaction;
receive a template for screening said received data identifying said reference entity;
screen said received data according to the received template identifying said reference entity for accuracy;
identify a contractual relationship between said reference entity and said at least first reference obligation;
assigning verification activities to users along with associated materials for facilitating a verification;
output a data record associated with said derivative transaction, said data record including said data identifying said reference entity...”

Applicant submits May does not discuss or render obvious at least these elements from independent claim 1...”

Response:

Upon review of the arguments presented on pages 11-18 it appears that a mapping of claimed elements should clarify the record. Accordingly a map of claim 1 follows immediately below.

1. A system to support a derivative transaction, comprising:

a memory (See, for example, Figures 2, 3, items 64, 98, etc);

a processor (See, for example, Figures 2, 3, items 50, 82, 112, etc) disposed in communication with said memory, and configured to issue a plurality of processing instructions stored in the memory, wherein the processor issues instructions to:

receive data identifying a reference entity participating in said derivative transaction (See, for example, Figure 24, item 504 and associated text);

receive a template for screening said received data identifying said reference entity (See, for example, Figure 25, item 512 and associated text, wherein it is understood

that the order data is being entered into a template that was received by the system at an earlier date);

screen said received data according to the received template identifying said reference entity for accuracy (See, for example, Figure 25, item 512 and associated text wherein it is understood that the information MUST be accurate for the order to be legal and proper accordingly it must be screened for accuracy);

receive data identifying at least a first reference obligation associated with said derivative transaction (See, for example, Figure 24, item 506 and associated text);

receive a template for screening said received data identifying said at least a first reference obligation (See, for example, Figure 25, item 512 and associated text, wherein it is understood that the order data is being entered into a template that was received by the system at an earlier date.);

screen said received data according to the received template identifying said at least a first reference obligation for accuracy (See, for example, Figure 25, item 512 and associated text wherein it is understood that the information MUST be accurate for the order to be legal and proper);

identify a contractual relationship between said reference entity and said at least first reference obligation (See, for example, Figure 24, item 508 and associated text, specifically “code the order information”, Figure 26, item 524, etc.);

assign verification activities to users along with associated materials for facilitating a verification (See, for example, Figure 24, item 508 and associated text, specifically reads on the act of “utilizing...preference information”);

output a data record associated with said derivative transaction, said data record including said data identifying said reference entity, said data identifying said at least first reference obligation, and data identifying said contractual relationship, wherein said data record is verified as accurate as of an issue date of said derivative transaction; and

using said outputted data record associated with said derivative transaction to execute a derivative agreement involving said reference entity and said at least a first reference obligation (See, for example, Figure 24, item 508 and associated text).

As set forth above, May does indeed disclose applicant's claimed invention. Accordingly the rejections set forth in the aforementioned sections are sustained and incorporated by reference as set forth independently below.

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 101

7. **Claims 1, 8 and 11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

In the communication received 5/7/2009, Applicant amended each claim to recite, inter alia, "...assign(ing) verification activities to users along with associated materials for facilitating a verification..." (emphasis added).

Per MPEP 2105:

“If the broadest reasonable interpretation of the claimed invention as a whole encompasses a human being, then a rejection under 35 U.S.C. 101 must be made indicating that the claimed invention is directed to nonstatutory subject matter “

Since page 6, lines 1-5 of the specification as filed, defines the term “user” as a human being (“trader”, “trade administrator”), and the limitation “for facilitating a verification” can be reasonably interpreted to mean that the verification is performed by “the user”, the claims are rejected as being directed to nonstatutory subject matter as they encompass a human being. That is, the method/system as claimed cannot be performed/constructed/completed without a human beings interaction and thought process “facilitating a verification”.

Claim Rejections - 35 USC § 112

8. Claims 1, 8, 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 8 and 11 are vague, indefinite and incomplete in what all is meant by and encompassed by the phrase “assigning verification activities to users along with associated materials for facilitating verification” because it is unclear whether the user is performing the verification or what the materials are that “facilitate” verification, or how and in what manner the materials facilitate verification. Since it is unclear whether applicant is attempting to claim the user, the metes and bounds of the claims are undefined.

Claim Rejections - 35 USC § 102

9. Claims 1-3 and 8-16 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by U.S. Patent 6,317,727 B1 to May for the reasons set forth in section 7 of the previous office action mailed 2/4/2009 which in turn refers back to section 8 of the previous office action mailed 7/8/2008.

See the discussion of this topic in section 5 above.

Claim Rejections - 35 USC § 103

10. Claims 1-3 and 8-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over May as applied to claims 1-3 and 8-16 above and further in view of U.S Patent 5,890,140 to Clark et al. for the reasons set forth in section 8 of the previous office action mailed 2/4/2009.

See the discussion of this topic in section 5 above.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL L. GREENE JR. whose telephone number is (571)272-6876. The examiner can normally be reached on Mon-Thur.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3694

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. L. G./
Examiner, Art Unit 3694
2009-08-03

/Mary Cheung/
Primary Examiner, Art Unit 3694